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Bernardo Nicolas Sanchez

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GOWAN INTELLECTUAL PROPERTY
1075 NORTH SERVICE ROAD WEST
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OAKVILLE, ON L6M-2G2
CANADA

EXAMINER

WONG, JOSEPH D

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/532,191	Applicant(s) SANCHEZ, BERNARDO NICOLAS	
	Examiner JOSEPH D. WONG	Art Unit 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 Nov 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20080428</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 April 2008 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Sull et al., (US 2002/0069218), hereinafter Sull.

As to claim 1, Sull shows a computerized method of information retrieval comprising: providing a computer displayable document having searchable content (interpreted to also include “multimedia file...images that contain text”, abstract); marking said document (interpreted to include “tag or bookmark”, abstract; Fig. 2), with a marking device (interpreted to include “bookmark”, paragraph [53]; Fig. 2; paragraph

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[0172]), as being a relevant document (paragraph [376]); storing said relevant document in a user defined separate (interpreted in light of the specification to be any distance or degree of separation e.g. Fig. 6 wherein the metadata and pointer, e.g. item 608 are separate from the content, e.g. item 606) data structure (interpreted to include “bookmarked position”, Fig. 12; [0211]) wherein said user defined data structure comprises a database of stored documents (Fig. 33) which are copied and stored on a storage device (Fig. 18) separate from said displayable document (wherein the degree or distance of separation is interpreted to be met by Fig. 6, items 608, 606); and conducting a search of a number of said relevant documents using a search engine to identify documents with a desired searchable content (paragraph [53]), Fig. 15; [214]); comparing said stored document with an updated copy of said stored document (see ¶[518], Figs. 43-44; Claim 72); selecting, using a selection device (Fig. 2; paragraph [0172]), the documents identified as having said desired searchable content (paragraphs [0051-0053]), and displaying either said original stored copy, or an updated image (interpreted to include “refresh frames”, paragraphs ¶[301, 313]) of said selected document (interpreted to include “query”, “search”, and “play”, from Fig. 6, 3, 2).

As to claim 2, Sull shows a computerized method as claimed wherein a visible document is displayed, and said computerized method is operated by accessing a computerized device selected from the group consisting of stand alone computers, laptop computers, (Fig. 45, item 4524), PDA's (Fig. 45, item 4522), and an Internet enabled cellular phones (Fig. 45, item 4518). ([35])

As to claim 3, Sull shows a computerized method as claimed wherein said document is selected from the group consisting of Internet web pages (Fig. 61), word processor documents (interpreted to be optional), spreadsheets (interpreted to include a “matrix”, [380]), e-mails ([355, 365]), and a database file (paragraph [380]).

As to claim 5, Sull shows a computerized method as claimed wherein said document is stored on said separate storage device (Figs. 18-19, wherein the video is stored in a video server, element 1804 and the server network has the video database connected to element 1804, element 1806 as per paragraphs [270-271], where separate is interpreted to mean distinct in occurrence) together with a file location and name, or with a URL addresses specific for said document (paragraphs [172-173, 321]).

As to claim 6, Sull shows a computerized method as claimed wherein said document is stored on a separate storage device selected from the group consisting of said user's computer (Fig. 68, item 6808, “metadata db” and item 6810, “video streams” storage cylinders), local storage device, remote storage device ([328]), network storage device ([411]), Internet storage device ([521]), and Application Service Provider storage device ([290]).

As to claim 7, Sull shows a computerized method as claimed wherein said searchable content is selected from the group consisting of text (Fig. 15, items 1516, 1518), highlighted text ([349], [355], [363]), notes ([288]), annotations ([288]), summaries (Table 4, [366]) and attachments ([353]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sull in view of Tims et al, (US 6,151,626) hereinafter Tims.

As to claim 9, Sull does not explicitly show a computerized method as claimed wherein access to said relevant content is controlled by a permission based authorization system.

However, Tims, shows a computerized method as claimed wherein access to said relevant content is controlled by a permission based authorization system. (see claim 16)

Sull and Tims are analogous art pertinent to the problem to be solved. A skilled artisan would have been motivated to combine Sull and Tims because it provides for restricted access to certain games or other services where payment is required as discussed in Tims, Col. 1, Lines 17-20.

Therefore at the time of invention, it would have been obvious to a person having ordinary skill in the art to combine Sull and Tims because it provides for restricted access to certain games or other services where payment is required as suggested in Tims, Col. 1, Lines 17-20.

Response to Arguments

Arguments are fully considered and grounds of objection or rejection are withdrawn where persuasive and maintained where not persuasive.

Objections

Claim objections are withdrawn.

Rejection under 35 U.S.C. §102

On page 6, paragraph 1, Applicant appears argues that the instant claimed invention does not teach “simple method for a user to identify and save **actual copies**” and “a relevant document, to a user defined, separate storage system”. However, this argument is not commensurate with instantly amended independent claim 1 because the claim recites “updated copy” and “in a user defined separate data structure”. Instant claim 1 does not recite "**actual copies**" or "**to a** user defined, separate storage system" as argued. Therefore the prior art rejection of instant claim 1 stands.

On page 7, paragraph 5, Applicant argues that Sull does not teach “store a copy of the relevant document in a separate, searchable, user-defined database”. However, Sull teaches a separate copy in the “metafile 4 of a virtually edited video" in Fig. 33 and Fig. 16, item 1608, teaches "send email with bookmark info". wherein an e-mail is reasoned to be a copy. Separate content copies are shown in Fig. 2, items 220 and 226 for contents and items 224 and 218 for positional information. Note that the claim does not require

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the original to be retained because it recites "displaying either said original stored copy, or an updated image". Therefore claim 1 stands rejected.

On page 7, paragraph 6, Applicant argues that Sull does not teach "the relevant document and by this is meant a complete copy of the relevant document rather than just a tag or bookmarked position) to be saved to a separate data structure. However, this argument is not commensurate with the instant claim 1 which recites, "documents which are copied and stored". Sull's portable bookmarks are effectively partial copies (Fig. 7) that are designed to maintain partial validity even after editing (Fig. 33). Note that the instant claim and specification has been checked and the antecedent basis for the term "complete copy" in the argued phraseology has not been found and cannot be added to the claim until support is identified. Therefore the prior art rejection of claim 1 stands.

On page 8, paragraph 4, Applicant argues that Sull does not teach "separate storage of the original file itself". However, this argument is not commensurate with the instant claim 1 appears directed to an alternative of "displaying either said original stored copy, **or** an updated image of said selected document". Applicant further argues that a perceptually relevant image would not necessarily be in agreement with the user's preference with respect to relevant documents. However, a perceptually relevant image meets the limitation of a relevant document copy because the claim does not require that the copy be complete as previously argued. Therefore claim 1 stands rejected.

On page 9, paragraph 1, Applicant argues that Sull does not teach "storage of the original file". However, Applicant argues a limitation not claimed as claim 1 instantly recites "copied and stored on a storage device separate from said displayable document"

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and “displaying either said original stored copy, **or** an updated image” which claimed as an alternative. Therefore claim 1 stands rejected.

On page 9, paragraph 2, Applicant argues that Sull does not teach “stored copies in a user defined database structure that can be searched by the user”. However, Sull displays play > and forward >> and reverse << button icons which the user can use to search as shown in figure 2. Therefore claim 1 stands rejected.

On page 9, paragraph 4, Applicant argues that Sull does not teach “mechanism to still be able to view the older file content”. However, Applicant argues a limitation not in instant claim 1. Claim 1 instantly recites “copied and stored on a storage device from said displayable document” such that the word “still” appears absent from instant claim 1. The instant claim merely requires that a copy be stored on a separate device but is not limited to “still displayable document” as the argument is best understood. Therefore claim 1 stands rejected,

On page 9, paragraph 5, Applicant argues that the cited portions of Sull do not teach “storage or selection of relevant materials from a stored copy of the original document”. However, Sull teaches in paragraph [376] an image link is the storage or selection of relevant materials from a stored copy of the original document because perceptually relevant images (PRI) are kept linked with the bookmark. Therefore claim 1 stands rejected.

On page 10, paragraph 1, Applicant argues that Sull does not teach “separate storage of a copy of the original document, and for search and identification of relevant content from the stored copies”. However, this argument is moot because it is not commensurate with instant claim 1. Sull teaches instant claim 1 which recites the

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alternative of "displaying either said original stored copy, or an update image" (Fig. 2, following a bookmark to a stored copy in item 210 for display 204; Fig. 33, virtual edit copy is retrievable). Instant claim 1 recites Sull also teaches "conducting a search of a number of said relevant documents using a search engine to identify documents with a desired searchable content" (see play > icon and >> fast forward and << reverse icons in Fig. 2). Instant claim 1 does not limit the search to the stored copies of the original document as argued as any copy would meet the limitation. Therefore claim 1 stands rejected.

On page 10, paragraph 2, Applicant appears to argue that Sull does not teach "an attempt to determine whether a new file exists, and thus show either the update filed or the stored file". However, this argument is not commensurate with the word "new" is not observed in instant claim 1. Sull teaches in Fig. 33 a virtual edit is stored and displayed as metadata therefore a new file exists and an update also. Therefore claim 1 stands rejected.

On page 10, paragraph 4, Applicant argues that Sull cannot anticipate the present invention of claim 1. However, these arguments are NOT persuasive as discussed above. Therefore claim 1 stands rejected under 35 USC 102(b) using Sull.

On page 11, paragraph 2, Applicant argues that Sull does not teach "document itself is stored in a fashion that the stored document, in its original form, is located in a search database". However, this argument is not commensurate with the scope of instant claim 1 because claim 5 does not recite the word "fashion". Claim 5 merely requires the "document is stored on said separate storage device together with a file location and name or (alternatively) with a URL addresses specific for said document". Sull teaches

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the document database (Fig. 18, item Video disk item 1812) can store URL's or pointers to document (Fig. 18, item 1806, Video DB) specific for said document (URL associated with video retrieved from disk 1812). Therefore claim 5 stands rejected under 35 USC 102(b) using Sull.

On page 11, paragraph 3, Applicant argues that Sull does not teach "original file content is stored in a user database" for claim 5. However, this argument is not commensurate with instant claim 5 which recites "said document is stored on said separate storage device together with a file location and name or with a URL addresses specific for said document". The claim merely requires the document to be stored on a separate storage device with a file location and name or URL addresses specific for said document (Fig. 18, wherein the video meets a document and the video server and video database are separate because the claim does not specify the amount of degree of separation needed to meet the claim). Applicant further argues that Sull does not teach "saving a copy of the original information" without pointing to instant claim 1 or 5. However, this argument is not commensurate with the language of claim 1 which recites the instantly claimed ALTERNATIVE of "displaying either original stored copy, or an update image" or "stored documents which are copied and stored on a storage device separate from said displayable document". The claim does not require "saving a copy of the original" as partial replay information or bookmark content from Fig. 2 of Sull would meet the language of instant claim 5. Therefore claim 5 stands rejected.

On page 12, paragraph 2, Applicant argues that Sull does not teach "storage of a copy of a relevant document in a user defined database, and providing the ability to search the user defined database to access the relevant documents (regardless of whether

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the original source of the relevant document is still available to the user)”. However, Applicant’s parenthetical limitations argue limitations are not claimed thereby rendering the argument moot. Claim 1 requires the alternative displaying either the original stored copy or an updated image it does not specifically require that the relevant document is **still** available to the user as argued. Therefore Sull anticipates all instantly pending claims under 35 USC 102(b).

Rejection under U.S.C. §103

On page 12, paragraph 3, arguments against the 103(a) rejection under Sull in view of Prakash are moot in view of new grounds of rejection under Sull in view of Tims as necessitated by the instant claim of independent claim 1.

For at least the reasons above, all pending claims stand rejected.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Wong whose telephone number is 571-270-1015. The examiner can normally be reached on Mondays through Fridays from 10 AM – 6PM.

Applicant initiated interviews may be formally requested in advance by faxing a completed PTO-413A form to the Examiner’s personal fax number at 571-270-2015. Form PTO-413A is used by the Examiner to prepare for any proposed interview. A detailed agenda listing should be attached including any proposed claim language and/or

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arguments that will be presented. This form is used to determine whether any proposed interview would advance prosecution and fit within a prescribed time limit.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim T. Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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2168

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25 July 2008

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